



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/809,649

03/25/2004

Earl David Forrest

60137-238; 445-3115-U

7491

26096 7590 04/25/2008
CARLSON, GASKEY & OLDS, P.C.
400 WEST MAPLE ROAD
SUITE 350
BIRMINGHAM, MI 48009

EXAMINER

MAH, CHUCK Y

ART UNIT

PAPER NUMBER

3677

MAIL DATE

DELIVERY MODE

04/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LIBERTY HARDWARE MANUFACTURING CORPORATION

Appeal 2008-0431
Application 10/809,649
Technology Center 3600

Decided: April 25, 2008

Before RICHARD TORCZON, JAMES T. MOORE, and DAVID B.
WALKER, *Administrative Patent Judges*.

Filed by TORCZON, *Administrative Patent Judge*; concurring opinion by
WALKER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

The appellant, Liberty, seeks review under 35 U.S.C. § 134 (2002).
We have jurisdiction under 35 U.S.C. § 6(b) (2002). Claims 1, 5-10, and

12-20 stand rejected under 35 U.S.C. § 102(b). The prior art relied upon by the examiner in rejecting the claims on appeal is:

Keeler US 3,430,994 4 March 1969

The rejection is AFFIRMED.

THE CLAIMED INVENTION

Liberty discloses decorative knobs that connect onto a dimmer switch shaft used to adjust room lighting. The examiner rejected all sixteen pending claims. Liberty offers separate arguments for seven claims on appeal. Claim 1 is broadly representative of the claims, and is reproduced (from the Claim Appendix of the appeal brief) below:

A dimmer switch knob comprising:
a dimmer switch knob having an inner bore, said inner bore being non-cylindrical;
an intermediate member having an inner bore to receive a shaft from a dimmer switch, said intermediate member having a non-cylindrical outer periphery; and
said non-cylindrical inner bore and said non-cylindrical outer periphery mating to provide a contact surface such that rotation of said dimmer switch knob rotates and intermediate member, said contact surface includes three lobes extending from said intermediate member, and three notches formed said intermediate member;
said three lobes extending from said outer periphery and fit into said three notches; and
said intermediate member is generally A shaped.

ANTICIPATION UNDER § 102(b)

Issue

Has Liberty established that the examiner erred in determining that the prior art anticipated the contested limitations of the claims?

FINDINGS OF FACT

1. Keeler discloses an apparatus that connects a knob to a shaft for controlling gas burner and other devices (Keeler, col. 1, ll. 56-60).

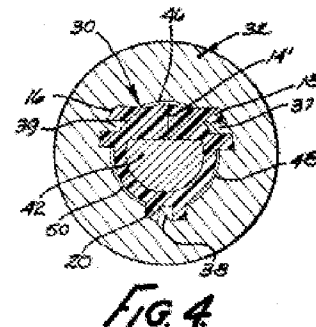
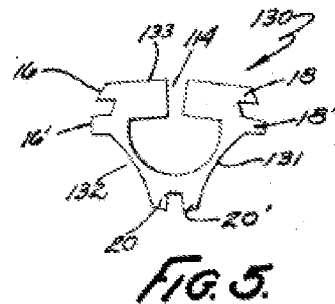
2. Keeler discloses a knob **32** having an inner bore that has a non-cylindrical cross section (Keeler's Figure 4, below).

3. Keeler discloses an intermediate member **30** having an inner bore to receive a shaft **42** from a control valve (Keeler, Figure 4).

4. Keeler discloses an intermediate member **130** having a non-cylindrical outer periphery (Keeler Figure 5, right).

5. Keeler's Figure 5 discloses an opening **114** in the intermediate member between the ridges **16**, **16'** and **18**, **18'**.

6. Keeler discloses that squeezing an intermediate member **30** together allows the knob to fit snugly about the control shaft **42** shown in Keeler's Figure 4 (right) thereby creating a frictional engagement between the control shaft **42** and the

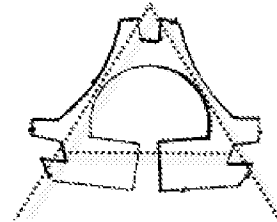


knob **32** such that rotation of the knob **32** rotates the intermediate member **30** (Keeler, col. 4, ll. 35-44).

7. Keeler discloses that the outer periphery of the intermediate member **30** must match up with the inner bore of the knob **32** when the apparatus is assembled (Keeler Figure 4).

8. Keeler's discloses an intermediate member **30** having a plurality of ridges (lobes) extending from the intermediate member that go into notches **37, 38, 39** in the knob **32** (Keeler, col. 2, ll. 56-70).

9. Keeler discloses a generally "A" shaped intermediate member. (Keeler's Figure 5 has been rotated and dotted lines added to illustrate the shape).



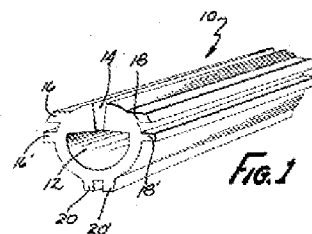
10. We note that flame intensities from gas burners may be adjusted.

11. We note that varying flame intensities produces varying light levels.

12. We note that gas burners include gas camping lanterns, gas stoves and other devices.

13. We note that the side lobes angle of the intermediate member changes when it is squeezed into the notches of the knob in the Keeler reference.

14. Figures 1 (right), 4 and 5 (above) from the Keeler reference disclose a plurality of different embodiments for the intermediate member **10, 30, and 130**.



15. Keeler discloses an assembly that includes the knob, intermediate member and control shaft in Figure 4 (above).

16. Liberty's specification states that dimmer switch shafts vary in design and size (Spec. at 0003).

17. Keeler discloses an intermediate member having side lobes spaced at an obtuse (i.e., greater than flat) angle when not compressed (top of Keeler Fig. 5, above).

18. The notches in Keeler's knob, however, are spaced to hold the compressed intermediate member at a flat (i.e., less than obtuse) angle (top of notch in Keeler Fig. 4, above).

PRINCIPLES OF LAW

A claim anticipates only if each and every element in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

After the examiner establishes a reasonable basis for anticipation based on inherency, the burden shifts to appellant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. *In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986).

The applicant has the burden on appeal to the Board to demonstrate error in the examiner's position. *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990).

Claim language is read in light of the specification as a person of ordinary skill would interpret it. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Arguments of counsel cannot take the place of evidence lacking in the record. *Estee Lauder Inc. v. L'Oreal, S.A.*, 129 F.3d 588, 595 (Fed. Cir. 1997).

A reference may be from an entirely different field of endeavor than that of the claimed invention, yet the reference will still anticipate if it explicitly or inherently discloses every limitation recited in the claim. *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997).

An apparatus claim covers what the device is, not what a device does, *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990).

ANALYSIS

Claim 1

Liberty argues the Keeler reference does not include the claim limitation of an inner bore to receive a shaft from a dimmer switch (Br. at 5). We give the claim its broadest reasonable construction consistent with the specification. In the specification, Liberty states the shaft varies in size and design (Finding 16). The specification does not set forth any limitation on the shape or size of the dimmer switch shaft such that we would have to read a particular structural limitation into the claim. We therefore find Keeler anticipates claim 1 because we must construe the claim as broadly as is

reasonable in view of the specification. Such breadth encompasses Keeler's intermediate member, including of findings 2-9 above which anticipate each of the claim elements.

Liberty's second argument is that the sole purpose of Keeler's intermediate member is to insulate the handle from the gas burner (Br. at 4). We disagree since the intermediate member has a far more complex shape than would be necessary if its "sole" function were insulation. In any case, we find that all claim limitations are disclosed in the reference (Findings 2-9). Liberty has not supplied any evidence to support its argument. Arguments of counsel cannot take the place of evidence in the record.

Alternative analysis for claim 1

Alternatively, although Liberty argues that the claim is limited to use with light dimmer switches, the examiner argued that the Keeler patent includes an intermediate member having an inner bore to receive a shaft from a dimmer switch. The examiner determined that, broadly interpreted, a control valve may be considered a switch to vary light levels for gas stove appliance (Ans. at 7). We additionally find that one of ordinary skill in the art would recognize that the Keeler reference can control light intensities levels (Findings 10, 11 and 12). Based on the appeal record before us, we further conclude Liberty has failed to show the examiner has erred in concluding claim 1 is not patentable in view of the Keeler patent.

Claim 6

Liberty argues that claim 6 covers an apparatus where the apex lobe is generally stiffer than the side lobes, and contends this limitation is not in the Keeler reference (Br. at 5). The examiner explains that the two side ridges of the Keeler reference are less stiff than the apex ridge because of the opening between them. According to the examiner, at the open position a flexure movement inward or outward of either of the side lobes relative to one another can be achieved. However, due to the spacing of the central apex lobe from the side lobes and the opening, the central apex lobe is generally stiffer than the side lobes if the same flexure movement is made at the central apex location (Ans. at 7).

We find the examiner has provided a rationale that reasonably supports the finding the side lobes are less stiff than the apex lobe. Liberty has not put forth persuasive evidence to the contrary, and as a result has failed to meet the burden of proving that the subject matter shown to be in the prior art does not possess the characteristic relied on by the examiner.

Claim 7

Liberty argues that the claim limitation that the apparatus have side lobes with spacing at an angle greater than the angle spacing corresponding to the notches in the knob is not in the Keeler reference (Br. at 5). We find that this claim limitation is in the Keeler reference (Findings 13, 17 and 18). Liberty has therefore not shown reversible error.

Claim 10

Liberty restates its arguments for claim 1, and further argues that claim 10 requires a kit that has a plurality of intermediate members (Br. at 5). The previous discussion regarding claim 1 applies equally here. With regard to the claim limitation of a kit, the Keeler reference discloses a plurality of intermediate members that can be used for a variety of devices (Findings 1 and 14). Liberty's kit is a collection of intermediate members consistent with Keeler's selection of members. Control shafts and knobs come in a variety of shapes and sizes depending on the device (Findings 1 and 12). Therefore, the Keeler reference taken as a whole discloses a plurality of intermediate members to be matched to the appropriate knob, consistent with the limitations of claim 10. Liberty has not shown reversible error.

Claim 15

Claim 15 depends from claim 10 and shares a limitation with claim 6. Liberty gives no additional arguments for claim 15. Since we found Liberty's arguments for claims 6 and 10 unpersuasive, we hold that Liberty has not shown reversible error.

Claim 16

Claim 16 depends from claim 10 and shares a limitation with claim 7. Liberty offers no additional arguments for claim 16. Since we found

Liberty's arguments for claims 7 and 10 unpersuasive, we hold Liberty has not shown reversible error.

Claim 19

Claim 19 recites a method claim for providing, selecting, and assembling an intermediate member to match a dimmer switch shaft and knob (Br. at 6). We find the Keeler reference provides for a plurality of intermediate members for different devices (Finding 14). Keeler discloses that the intermediate member must be selected to match the knob and the control shaft (Findings 6 and 7). Finally, Keeler teaches how to assemble the knob, intermediate member, and control shaft together (Finding 15). Therefore, Keeler teaches all the claim elements of claim 19.

Liberty has not shown reversible error.

CONCLUSION

Liberty has failed to show that the examiner erred in rejecting the claims over the prior art. The decision of the examiner to reject claims 1, 5-10, and 12-20 under 35 U.S.C. § 102(b) as anticipated based on a patent to Keeler is —

AFFIRMED

WALKER, *Administrative Patent Judge*, Concurring,

I join the majority in affirming the Examiner's rejections of claims 1, 5-10, and 12-20. I agree with the majority's rationale in reversing the Examiner's rejections under 35 U.S.C. § 102(b) with the exception of the section styled as "Alternative analysis for claim 1" and Findings of Fact 10-12 associated therewith. Because I believe that analysis and those facts are unnecessary to the disposition of the rejection of claim 1, the Board need not, and I would not, reach the "Alternative analysis for claim 1" relied on by the majority.

The majority correctly found that Keeler teaches all of the limitations of claim 1 (Findings of Fact 2-9, Majority Op. at 6). Because that is all that is required to anticipate claim 1, the majority properly affirms the Examiner's rejection of claim 1 as anticipated by Keeler. The Appellant argues that Keeler discloses an insulated handle for use on a gas burner for a stove, which is placed intermediate a knob and a shaft, but the member's sole purpose is to insulate the knob against the high heat experienced at the valve (Br. 4, citing, for example, Keeler, the paragraph beginning at col. 2, l. 11). The Appellant asserts that Keeler would thus have no application with a dimmer switch, and cannot properly meet the claim (Br. 4).

To the extent that the Appellant argues that the use of the insulated handle of Keeler does not anticipate the claimed dimmer switch, even if it discloses the identical structure claimed, it is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable. See *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir.

1997). When the claimed structure is already known, as it is in Keeler, it is immaterial whether the Keeler structure actually has been used as a dimmer switch. *Id.* The Appellant has provided no evidence that the structure of Keeler is not capable of operating as a dimmer switch. The Appellant's arguments therefore are not persuasive, because the Appellant has failed to show where the Examiner has erred, e.g. by showing that at least one of the limitations of claim 1 is not found, either expressly or inherently described, in Keeler. *Verdegaal Bros.*, 814 F.2d at 631.

Therefore, I concur in the result of affirming the Examiner's rejection of claims 1, 5-10, and 12-20 under 35 U.S.C. § 102(b) as anticipated by Keeler, but would affirm the rejection of claim 1 for the reasons stated above without reaching the "Alternative analysis of claim 1" applied by the majority.

MAT

CARLSON, GASKEY & OLDS, P.C.
400 WEST MAPLE ROAD
SUITE 350
BIRMINGHAM MI 48009